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REMARKS

Claims 1-20 are pending in this application, and these claims have been cancelled by the amendments above. New claims 21-36 have been added. Claim 21 is an independent claim from which all other claims depend, either directly or indirectly. Claim 21 corresponds to an amended, previously-presented claim 1. Support for the newly-added claims is in the specification and originally-presented claims. No new matter is believed to be added.

Applicants submit that the amended claims above overcome the rejections based on 35 U.S.C. §§112, first paragraph, 102(b) and 103(a). Applicants request reconsideration and withdrawal of these rejections for the reasons set forth herein.

1. The Rejections Under 35 U.S.C. §112, First Paragraph

A. The Examiner has rejected claims 1-20 under 35 U.S.C. §112, first paragraph, stating that the specification is not enabling for "complexes". In response, Applicants have deleted this phrase from the broadest claim (claim 21). Applicants respectfully submit that this ground for rejection has now been rendered moot. Withdrawal of this rejection is requested.

B. The Examiner has rejected claims 17-20 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner maintains that the method of treatment claims would require one skilled in the art an undue amount of experimentation to demonstrate the utilities of the claimed invention. Applicants do not agree with the Examiner's rejection. However, solely to expedite allowance of the instant application, Applicants have cancelled the method of treatment claims (claims 17-20). Applicants reserve the right to file continuation applications directed to the cancelled subject matter.

2. The Rejections Under 35 U.S.C. §102(b)

The Examiner has rejected the claims under 35 U.S.C. §102(b) as follows:

- a. claims 1, 2 and 8 over Stajer, et al.
- b. claims 1, 2, 3 and 8 over Fulop, et al.
- c. claims 1, 2 and 8 over Schubert, et al.
- d. claims 1, 2 and 8 over Spiro, et al.
- e. claims 1, 2, 4, 6 and 8 over Kato, et al.
- f. claims 1-3, 7 and 8 over Mitter, et al. (1927)
- g. claims 1, 2 and 8 over Mitter, et al. (1925)

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- h. claims 1, 2 and 8 over Mitter, et al. (1923)
- i. claims 1, 2, 4, 6 and 8 over Arai, et al.
- j. claims 1, 2, 4, 6 and 8 over Tice, et al. (2001)
- k. claims 1, 2, 4 and 8 over Jayakumar, et al.
- l. claims 1, 2, 8 and 9 over Rossi, et al. (1999)
- m. claims 1, 2 and 8 over Mukherjee, et al.
- n. claims 1, 2 and 8 over Tice, et al. (1998 – Tice I)
- o. claims 1, 2 and 8 over Tice, et al. (1994 – Tice II)
- p. claims 1, 2 and 8 over Rossi, et al. (1997)
- q. claims 1, 2, 8 and 9 over Holzer, et al.
- r. claims 1, 2, 4, 5 and 8 over Mazumdar, et al.
- s. claims 1, 2, 4, 8 and 16 over Gupta, et al. and
- t. claims 1, 2, 4, 6, 8 and 16 over Ruschig, et al.

The Examiner maintains that each of the above-noted references contain compounds that fall within the scope of the originally-presented claims. By the above amendments, the broadest claim (claim 21) has been narrowed such that the definition of R⁴ has been limited to —(CH₂)_n—R⁵ wherein n is 2, and R⁵ is aryl, which is optionally substituted by 1 to 3 substituents on the aryl and each substituent is independently H, halogen, lower alkyl or lower alkoxy. Support for this amendment can be found in the specification on page 4, paragraph 16, the last sentence of the paragraph. Applicants respectfully submit that this narrowed definition for -(CH₂)_n—R⁵ makes claim 21 and dependent claims 22-36 allowable. Reconsideration and withdrawal of these rejections is requested.

3. The Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1, 2, 4-6, 8 and 16 under 35 U.S.C. §103(a) over: (i) each of Tice I and Tice II, each taken separately; (ii) Gupta; and (iii) Ruschig. The Examiner maintains that each of these references renders obvious the homologs and isomers of the instant invention. Applicants respectfully traverse the 103 rejections.

Applicants submit that the none of the compounds disclosed in the cited 103 references contain homologs to the instant compounds. The compounds in the instant application have a R⁴ group with an ethylene linker inbetween the nitrogen in the core ring structure and the terminal phenyl of the —(CH₂)_n—R⁵ substituent. Also, the amended broadest generic claim (claim 21) now has the —(CH₂)_n— linker group limited to n as 2, which means that the genus only covers the ethylene linker group. This can be distinguished from compounds in the cited 103 references where, at best, the compounds contain a phenyl group directly attached to the nitrogen in the same position of the core ring

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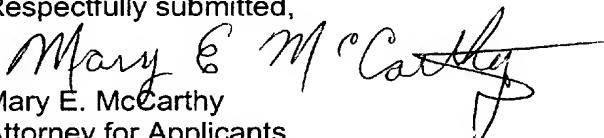
structure. In other words, there is no alkylene spacer, much less an ethylene spacer. Applicants respectfully submit that the presence of the ethylene linker in the R⁴ group clearly distinguishes the claimed compounds from those in the cited 103 references. There is no suggestion or teaching in these references to make the ethylene modification.

Additionally, the 103 references and the claimed invention do not share the same utility. The current invention claims compounds that are calcylitics useful in treating bone and mineral diseases, such as osteoporosis. None of the 103 references are directed to this same utility. Tice I and II compounds are described as being useful as herbicides. Gupta discloses that the compounds of his invention are useful as antiinflammatory and CNS agents, while Ruschig discloses compounds having narcotic, hypnotic, sedative, analgesic, antipyretic and antiphlogistic activities. Absent the same utility, one skilled in the art would not be motivated to modify the the compounds in the 103 references.

Based on the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §103(a).

In view of the foregoing amendments and remarks, Applicants respectfully submit that all the claims in the application are in condition for allowance. Reconsideration and withdrawal of the rejections is requested. Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned attorney at the number below.

Respectfully submitted,


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